

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR CLAIM AMENDMENTS

Support for the amendments to the claims can be found in the drawings as originally filed, for example, on FIGS. 7 and 9 and in the specification as originally filed, for example, on page 22, line 21 through page 23, line 14. As such, no new matter has been introduced.

IN THE DRAWINGS

While Applicant's representative does not necessarily agree with the requirement to label FIG. 1, in order to further prosecution, FIG. 1 has been labeled "conventional". A replacement FIG. 1 is submitted herewith. As such, the objection to the drawings should be withdrawn.

IN THE SPECIFICATION

The specification has been amended to update references to related applications and for consistency. As such, no new matter has been introduced.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-3, 10-15, 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Flanders et al. (U.S. Patent No. 6,115,379; hereinafter Flanders) in view of Cisneros et al. (U.S. Patent No. 5,166,926; hereinafter Cisneros) has been obviated by appropriate amendment and should be withdrawn.

The rejection of claims 4-9 and 16 under 35 U.S.C. §103(a) as being unpatentable over Flanders in view of Cisneros in further view of Byrn et al. (U.S. Patent No. 5,502,833; hereinafter Byrn) has been obviated by appropriate amendment and should be withdrawn.

Flanders is directed to a unicast, multicast, and broadcast method and apparatus (Title of Flanders). Cisneros is directed to a packet address look ahead technique for use in implementing a high-speed packet switch (Title of Cisneros). Byrn is directed to a system and method for management of a predictive split cache for supporting FIFO queues (Title of Byrn).

In contrast to the cited references, the presently claimed invention (claim 1) provides an apparatus configured to extract in-band information from a current packet or skip extraction of said in-band information and **perform a look ahead operation to a predetermined location in a next packet**, wherein said apparatus is configured to switch between said extraction of

said in-band information and skipping said extraction. Claims 12 and 13 include similar limitations.

The Office Action admits that "Flanders does not disclose that the logic circuit also performs a look-ahead operation" (page 3, line 9 of the Office Action). Since Flanders does not disclose that the logic circuit also performs a look-ahead operation, it follows that Flanders does not teach or suggest performing a look ahead operation to a predetermined location in a next packet, as presently claimed. Furthermore, the Office Action fails to present any objective evidence or convincing line of reasoning that one of ordinary skill in the field of the invention would consider the port mask of Flanders to be the same as the presently claimed in-band information.

Cisneros does not cure the deficiencies of Flanders. Specifically, the look-ahead technique disclosed by Cisneros is directed to "storing configuration information within each cross-point circuit, in every cross-point switching plane, on cell in advance of the actual cell that is being routed therethrough" (column 9, lines 7-11 of Cisneros). Since the look-ahead technique of Cisneros concerns storing configuration information within cross-point circuits in cross-point switching planes rather than a predetermined location in a packet, it follows that Cisneros does not teach or suggest an apparatus configured to extract in-band information from a current packet or skip extraction of said in-

band information and **perform a look ahead operation to a predetermined location in a next packet**, wherein said apparatus is configured to switch between said extraction of said in-band information and skipping said extraction, as presently claimed. Therefore, Flanders and Cisneros, alone or in combination, do not appear to teach or suggest each and every element of the presently claimed invention. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

With respect to claims 2, 3, 14 and 15, Applicants' representative respectfully traverses the Examiner's suggestion that it is inherent that the corresponding memory addresses for the packet must be generated because the switch changes between transmitting unicast and multicast packets. Inherency requires certainty of results, not mere possibility. See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). The Office Action fails to present any objective evidence or convincing line of reasoning to explain why the corresponding memory addresses for the packet must be generated because the switch changes between transmitting unicast and multicast packets.

With respect to claims 4, 8 and 9, the Examiner's conclusory statements that "it would have been obvious to one skilled in the art at the time of the invention to implement this

feature into Flanders because the use of pointer makes system more flexible and adaptable in storing data in buffers" does not adequately address the issue of motivation to combine. The factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. It is improper in determining whether a person of ordinary skill would have been led to a combination of references simply to use that which the inventor taught against its teacher. The Office must not only assure that the requisite findings are made based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Office's conclusion. The Office Action fails to make any specific findings of fact or present a convincing line of reasoning explaining why such findings are deemed to support a conclusion of obviousness. Therefore, the Office Action fails to meet the Office's burden to factually establish the *prima facie* case of obviousness (MPEP §2142). As such, claims 4, 8 and 9 are fully patentable over the cited references and the rejections should be withdrawn.

With respect to claims 5 and 6, the Examiner's conclusory statements that "it would have been obvious to one skilled in the art at the time of the invention to implement this feature into Flanders because using memory that uses pointer would make the system more flexible and adaptable" does not adequately address the issue of motivation to combine. The factual question of motivation

is material to patentability and cannot be resolved on subjective belief and unknown authority. It is improper in determining whether a person of ordinary skill would have been lead to a combination of references simply to use that which the inventor taught against its teacher. The Office must not only assure that the requisite findings are made based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Office's conclusion. The Office Action fails to make any specific findings of fact or present convincing line of reasoning explaining why such findings are deemed to support a conclusion of obviousness. Therefore, the Office Action fails to meet the Office's burden to factually establish the *prima facie* case of obviousness (MPEP §2142). As such, claims 5 and 6 are fully patentable over the cited references and the rejections should be withdrawn.

With respect to claims 7 and 16, the Examiner's conclusory statements that "It would have been obvious to one skilled in the art at the time of the invention to implement this feature into Flanders because pipelining allows operations to be simultaneously, therefore implementing it in Flanders would make the system operate faster" does not adequately address the issue of motivation to combine. The factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. It is improper in determining

whether a person of ordinary skill would have been lead to a combination of references simply to use that which the inventor taught against its teacher. The Office must not only assure that the requisite findings are made based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Office's conclusion. The Office Action fails to make any specific findings of fact or present convincing line of reasoning explaining why such findings are deemed to support a conclusion of obviousness. Therefore, the Office Action fails to meet the Office's burden to factually establish the *prima facie* case of obviousness (MPEP §2142). As such, claims 7 and 16 are fully patentable over the cited references and the rejections should be withdrawn.

Claims 2-11 and 14-18 depend, directly or indirectly, from either claim 1 or claim 13 which are believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn. New claims 19 and 20 depend, directly or indirectly, from claim 1 which is believed to be allowable. As such, claims 19-20 are fully patentable over the cited references.

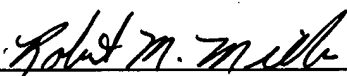
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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Dated: December 17, 2004

Docket No.: 0325.00409